PATENT

Attorney Docket No.: BEA9-2000-0003-US1

BOARD OF PATENT APPEALS
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Delany et al.		
SERIAL NO.:	09/656,320	Group Art Unit:	3624
FILING DATE:	September 6, 2000	Examiner:	Karmis
FOR:	**Method For Usage Billing In An Internet Environment**		

BRIEF OF PATENT OWNER ON APPEAL

1. Real Party in Interest

International Business Machines Corporation, a New York corporation, is the real party in interest.

2. Related Appeals and Interferences

There are no related appeals or interferences.

3. Status of Claims

Claims 1, 4-8, and 11-13 were previously presented. Claims 9, 10, and 14-17 were originally filed. Claims 2, 3, and 19 were cancelled. Claims 18 - 20 were added in response to a Non-Final Office Action dated December 14, 2005. Claims 1, 6, and 11 were amended after final and are currently being petitioned for entry into the record. Accordingly, claims 1, 4-18 and 20 are currently pending. The claims on Appeal are included in the Appendix.

4. Status of Amendments

Claims 1, 6 and 11 were amended after the Final Office Action to return these claims back to the form considered by the examiner in the Office Action dated September 14, 2005 for which a Response was filed on December 14, 2005. In a telephone discussion with the Examiner on May 30, 2006, the Examiner agreed that he would enter the amendment to the claims submitted After Final, and would acknowledge such in an Advisory Action. The Advisory Action was received on July 20, 2006 in which the Examiner denied entry of the amendment to claims 1, 6, and 11. Additionally, claim 19 was canceled after the Final Office Action.

5. Summary of the Claimed Subject Matter

Applicants' invention provides a method, system and article of manufacture for weighted-usage billing of customers based on the usage of a service provider's functions. More specifically, Applicants' invention utilizes a webserver's log file, user logon information and pre-determined weights of webserver functions to compute a weighted average use that accurately accesses the amount and type of functions performed by a user and that bills the user accordingly. The steps of Applicants' invention include assigning a weight to each of at least one webserver function; identifying at least one function accessed by a user from a file; determining a number of uses of each function by the user; and determining an amount of usage by combining the number of uses of the function with the function weight.

The first step in the Applicants' invention is to define a webserver function. As the Applicants' specification illustrates, a webserver function is a specific action performed by the webserver per the user's request. Specifically, as shown in the example on page 7, line 8 of the specification, "display product details," "search for products," and "place an order" are representative of the genre of functions that the invention contemplates. Though Applicants' invention is not limited to these three functions, these are illustrative of the types of webserver activities that encompass the definition of function as contemplated in the Applicants' invention.

The next important limitation in the Applicants' invention is to assign a weight to each of at least one webserver function. The assignment of a weight to each webserver function is accomplished in the Applicants' invention prior to a user logging onto the server. The weights may be assigned based upon a score of the system resource utilization of the respective function or may be assigned according to a scheme devised by the webserver provider. In one embodiment, a webserver may assign the weight according to the memory requirement of the function; the more the function taxes the ability of the webserver to run, the more weight that is assigned to that function. However, the Applicants' invention is not limited to this embodiment and weights may be assigned accordingly to any scheme pre-determined by the webserver. In any case, once the function is assigned a weight, the weights are stored in a static file on the webserver or a back-up file. A Usage Collector Agent (UCA) may then attribute these pre-assigned weights to a user's web activity.

The UCA, which can be in either hardware or software form, utilizes either a Web Server Log File or a User Log-on Information to evaluate the amount of time a user is logged on and the functions that are accessed or performed by a particular user. The UCA then obtains the weight of each function performed from the static file and multiplies the function weight with the number of times the function was performed by the user. When these numbers are tallied, this determines the total usage points of a user's activity and provides the basis from which the user may be billed. The bill is computed by multiplying the total usage points times the web-host rate per usage point. Accordingly, a mathematical representation for determining a bill would be as follows:

$(F_1 * W_1) + (F_2 * W_2) + \ldots (F_n * W_n) = U_{Total}$
$U_{Total} * R = B$

According to the above formula, F_1 represents a total number of a first function performed by a user and W_1 represents the respective weight pre-assigned to F_1. Similarly, F_2 represents a total number of a second function performed by a user wherein W_2 is the respective

pre-assigned weight of F_2. Accordingly, each separate function is represented by F with numerical subscript and accompanied by a respective preassigned weight (W). Each function performed (F_1 through F_n) is multiplied by its respective weight (W_1 through W_n) and tallied to determine the total units used (U_{Total}). The U_{Total} is then multiplied by the rate of usage (R) to establish the final usage bill (B).

In operation, a service provider would apply the above formula in the following manner. A first function, such as displaying product details, may be called F_1 and may be pre-assigned a weight (W_1) of 1. A second function, such as searching for products, may be called F_2 and may be pre-assigned a weight (W_2) of 5. A third function, such as placing an order, may be called F_3 and may be pre-assigned a weight of (W_3) of 11. Assume that User A performs F_1 once, F_2 twice, and F_3 once. The UCA would multiply the pre-assigned weight by the number of times that function was performed and tally each product to obtain the total usage (U_{Total}) as follows:

$(F_1 * W_1) + (F_2 * W_2) + (F_3 * W_3) = U_{Total}$
$(1 * 1) + (2 * 5) + (1 * 11) = U_{Total}$
$(1) + (10) + (11) = U_{Total}$
$22 = U_{Total}$

The UCA would then multiply U_{Total} by the rate per usage point (R) to obtain a final bill for the user's web activity. If, in the above example, the rate were $0.05 per usage point, then the bill would look as follows:

$U_{Total} * R = B$
$22 * 0.05 = B$
$1.10 = B

Accordingly, the Internet Provider is able to determine a bill for services provided to User A and,

as such, is able to send an invoice to User A.

6. Grounds of Rejection to be Reviewed on Appeal

Whether claims 1, 6 and 11 fail to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention under 35 U.S.C. §112, second paragraph.

Whether claims 1, 6 and 11 are unpatentable over *Wright* U.S. Patent Publication 2001/0027449 in view of "Dialog's DialUnits: A Price Increase in Sheep's Clothing," under 35 U.S.C. §103(a).

Whether claims 4-5 and 18 are unpatentable over *Wright* U.S. Patent Publication 2001/0027449 in view of "Dialog's DialUnits: A Price Increase in Sheep's Clothing," under 35 U.S.C. §103(a).

Whether claims 7-10 are unpatentable over *Wright* U.S. Patent Publication 2001/0027449 in view of "Dialog's DialUnits: A Price Increase in Sheep's Clothing," under 35 U.S.C. §103(a).

Whether claims 12-17 and 20 are unpatentable over *Wright* U.S. Patent Publication 2001/0027449 in view of "Dialog's DialUnits: A Price Increase in Sheep's Clothing," under 35 U.S.C. §103(a).

7. Argument

A. Rejection of claims 1, 6 and 11 under 35 U.S.C. §112.

In the Final Office Action of February 27, 2006, the Examiner assigned to the application rejected claims 1, 6, and 11 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as

the invention. The Applicants amended claims 1, 6, and 11 after final to overcome the Examiner's 35 U.S.C. §112 rejection. More specifically, Applicants have amended the claims herein to remove the language added in the December 14, 2005 Response and to place the claims into the condition they were with the submission of the June 13, 2005 Response. The claims of the June 13, 2005 Response were entered into the record by the Examiner and were considered by the Examiner in the Office Action of September 14, 2005. The Examiner, in the Office Action of September 14, 2005, did not raise any issue with the claims under 35 U.S.C. §112. Accordingly, the claims as currently amended do not contain any new matter and over come the current 35 U.S.C. §112 rejection. Although the outstanding Office Action is Final, Applicants respectfully request entry of the amendment as it does not raise any new issues that would require further consideration and/or search since this amendment of the claims merely removes the added language presented on June 13, 2005.

In the alternative, even if the amendment is not allowed into the record, when considering a rejection under 35 U.S.C. §112 the Examiner "should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.[1]" In other words, all that a claim must do is convey to one of ordinary skill in the art the limits of the claim. In the present case, the Examiner states that he is unsure whether the calculation of a fee based on time a user is logged on is considered within a bill to the user. With all due respect to the Examiner's interpretation, the claims 1, 6, and 11 teach that both fees are to be included within the bill. Specifically, claims 1, 6, and 11 claim a fee based on user time and a fee based on usage for each function. These fees are obtained and to be included in the bill to the user. While the bill limitation does expressly say that the bill includes the two fees, any ordinary person in the art would understand that the purpose of calculating the two fees is so that they may be included in the bill. If the fee

[1] MPEP 2173.02

for user time was not to be included in the bill, there would be no reason for its calculation. Accordingly, the Applicant believes that the Examiner's rejection under 35 U.S.C. §112 fails to follow the guidelines of the MPEP and respectfully requests the Board of Patent Appeals to direct claims 1, 6, and 11 to allowance.

B. Rejection of claims 1, 6 and 11 under 35 U.S.C. §103(a)

The Examiner rejected claims 1, 6 and 11 under 35 U.S.C. §103(a) as being unpatentable over *Wright*, U.S. Publication No. 2001/0027449, in view of "Dialog's DialUnits: A Price Increase in Sheep's Clothing" (hereinafter *Dialog*). However, the Examiner's evaluation of the *Wright* and *Dialog* references did not take into account that both references lack fundamental limitations of the Applicants' invention. Furthermore, the Examiner's evaluation did not elicit any motivation or suggestion to combine the *Wright* and the *Dialog* references. Because these basic requirements to uphold a rejection under 35 U.S.C. §103(a) were not met, Applicants respectfully request that the Board of Patent Appeals rule in Applicants' favor and direct allowance of claims 1, 6, and 11.

1. Discussion of the Contents of the Prior Art References Cited by the Examiner

The first and second steps required for evaluating a prior art reference under 35 U.S.C. §103(a) are to first determine the scope and contents of the prior art and then ascertain the differences between the prior art and the claims in issue.[2] In rejecting claims 1, 6 and 11 under 35 U.S.C. §103(a) as being unpatentable over *Wright* in view of *Dialog*, the Examiner takes the position that *Wright* is a computer implemented method for billing wherein a weight score is

[2] *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966) (holding that under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined).

established based upon a pre-assigned function.[3] Accordingly, the Examiner assumes that the only deficiency in using *Wright* as a prior art reference against the Applicants' invention is that it does not disclose that a weight for each function is established prior to the use of the function.[4] The Examiner believes that *Dialog* accounts for this deficiency in that *Dialog* discloses a pre-assigned billing rate for a Dial Unit.[5] However, upon closer inspection of the *Wright* reference, the specification reveals that lack of a pre-assigned weight for each function prior to the use of the function is not the only deficiency in using *Wright* as a prior art reference against the Applicants' invention. The use of an actual weighted unit multiplied against the number of functions performed to give a weighted score is also not contemplated by *Wright*.

Wright discloses a method for providing instantaneous usage and billing information to a user of Internet or other electronic digital services. More specifically, *Wright* discloses a method for rating usage of the Internet in real time such that an Internet provider may establish a bill for Internet, or other electronic digital service, usage and charges incurred. Typically, an Internet Service Provider measures the usage of their service through a metering device. The metering device collects data related to the provision of services and multiplies that data by a billable rate to obtain a billable unit. In *Wright*, the data that is metered may consist of "information directly relating to the units of service used. The units of measure include time, event, or functional units as predetermined by the service provider."[6] In other words, *Wright's* units of measure determines the units of service consumed. By tallying the units of measure, the metering device

---

[3] Office Action of September 14, 2005, page 3

[4] *Id.*

[5] *Id.*

[6] *Id.* at specification, page 2 paragraph 0026.

in *Wright* establishes the total service units consumed. The total service units consumed is then directly multiplied by an assessed rate per measured unit to obtain a billable unit that the webserver provider may use to bill the user.

A mathematical representation of *Wright's* formula would be as follows:

$$(F_1 + F_2 + ...F_n) * R = B$$

In the above formula, each F represents a separate service unit wherein each service unit (F_1 through F_n) is added to obtain the total service units consumed and is directly multiplied by a usage rate (R) to obtain a final bill (B).

Dialog teaches a computer implemented method for billing a user of a webserver through a "Dial Unit." More specifically, *Dialog* measures computer functions. Each function is referred to as a "Dial Unit." Similar to *Wright*, each "Dial Unit" is tallied to create a total usage of resources. This total usage of resources is multiplied by a pre-assigned rate to elicit a billable unit for the user. Interestingly, *Dialog*, much like *Wright*, does not multiply its Dial Unit by a pre-assigned weight when converting Dial Units into a total usage of resources. Thus, the mathematical representation of *Wright* is applicable to *Dialog* as well.

2. Discussion of Applicants' Invention in View of the Prior Art References and Prior Art References Failure to Teach All of the Claimed Limitations of Applicants' Invention

35 U.S.C. §103(a) requires that prior art references teach each and every element of an

invention to be upheld as a valid rejection.[7] Applicants' invention discloses a computer implemented system, method, and article of manufacture that converts a webserver function into a billable unit through a pre-assigned weight. More specifically, the webserver pre-assigns the weight of each individual function and stores each assignment in a static file. It is this important limitation of the Applicants' invention that the *Wright* reference and the *Dialog* reference do not teach or suggest and the reason that the requirements of 35 U.S.C. §103(a) have not been satisfied.

Applicants' computer implemented system, method and article of manufacture requires as its first limitation that a webserver function be assigned a weight. When a user initiates a session on a webserver, a Usage Collector Agent (UCA) keeps track of each function performed by the user. The UCA then multiplies each function performed by the pre-assigned weight and tallies them to obtain a total usage that reflects the pre-assigned weights. As discussed above, the UCA effectively applies the following formula:

$$(F_1 * W_1) + (F_2 * W_2) + \ldots (F_n * W_n) = U_{Total}$$

The total usage is then multiplied by a rate to obtain a user's bill, according to the following formula:

$$U_{Total} * R = B$$

Thus, certain targeted functions performed by the user cost more than other functions, as reflected by the varying pre-assigned weight of the functions. The *Wright* and *Dialog* references do not account for the pre-assigned weight of the Applicants' invention. Rather, *Wright* and *Dialog* multiply the number of functions performed directly by a rate.

[7] *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

$$(F_1 + F_2 + ...F_n) * R = B$$

Accordingly, there is no W or functional weight variable present in either the *Wright* reference or the *Dialog* reference that would account for varying costs of the functions performed by the user. The pre-assigned weight is a fundamental limitation to the Applicants' invention and is a major limitation not found in either the *Wright* reference or the *Dialog* reference.

To establish a rejection under 35 U.S.C. §103(a), all of the claim limitations must be taught or suggested by the prior art.[8] If the prior art references do not teach or suggest every claim limitation of the Applicants' invention, then they do not meet every requirement under 35 U.S.C. §103(a) and are not sufficient to uphold a rejection under 35 U.S.C. §103(a). In the present case, as stated above, the major difference between the Applicants' invention, the *Wright* reference, and the *Dialog* reference is that the *Wright* and *Dialog* references lack the fundamental, pre-assigned weight (W) limitation of the Applicants' reference. Therefore, because neither the *Wright* reference nor the *Dialog* reference discloses the pre-assigned weight limitation of the Applicants' invention, these prior art references do not teach every element of the Applicants' invention. Accordingly, the *Wright* and *Dialog* references, when combined, are not sufficient to uphold a rejection under 35 U.S.C. §103(a).

In addressing each of the Applicants' claims individually, claim 1 of the Applicants' invention teaches a method for billing comprising: assigning a weighted score to a webserver function, identifying a user, determining if the function is performed by the user, calculating an amount of usage by multiplying the number of times the function is performed by the pre-assigned weight for the function, tallying the amount of usage for each function and billing the user. The first limitation of claim 1 is that the method requires a pre-assigned weighted score for each function on a webserver. As noted above, neither the *Wright* reference nor the *Dialog*

[8] *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

reference teaches or suggests this limitation. Accordingly, the first limitation of claim 1 of the Applicants' invention has not been taught by any prior art reference, and a basic criteria for upholding a rejection under 35 U.S.C. §103(a) has not been met. Because the criteria for a rejection under 35 U.S.C. §103(a) has not be met, the Applicants respectfully request that the Board of Patent Appeals rule in Applicants' favor and direct allowance of claim 1.

With respect to claim 6 of the Applicants' invention, the claim teaches a system for billing comprising: a function that is assigned a weight and a user that may perform the function on the webserver such that a manager may track the number of uses of the function and may calculate a total usage by multiplying the weight of the function by the number of times the function was performed. Just as in claim 1, the first limitation of claim 6 is that the system requires a pre-assigned weight for each webserver function. Neither *Wright* nor *Dialog* teaches or suggests this limitation. Accordingly, the first limitation of claim 6 of the Applicants' invention has not been taught by any prior art reference, and a basic criteria for upholding a rejection under 35 U.S.C. §103(a) has not been met. Because the criteria for a rejection under 35 U.S.C. §103(a) has not be met, the Applicants respectfully request that the Board of Patent Appeals rule in Applicants' favor and direct allowance of claim 6.

With respect to claim 11 of the Applicants' invention, the claim teaches an article for billing comprising: a computer readable signal bearing medium storing instructions comprising: an instruction to preassign a weight to a webserver function, instructions for determining when the function is performed by a user, and instructions for calculating a usage amount by multiplying the number of functions performed by the pre-assigned weight. As in claims 1 and 6, the first limitation of claim 11 is that the article requires a pre-assigned weight for each webserver function. Neither *Wright* nor *Dialog* teaches or suggests this limitation. Accordingly, the first limitation of claim 11 of the Applicants' invention has not been taught by any prior art

reference, and a basic criteria for upholding a rejection under 35 U.S.C. §103(a) has not been met. Because the criteria for a rejection under 35 U.S.C. §103(a) has not be met, the Applicants respectfully request that the Board of Patent Appeals rule in Applicants' favor and direct allowance of claim 11.

As noted above, independent claims 1, 6, and 11 all include a limitation that requires the invention to assign a weight to a webserver function. Neither reference cited by the Examiner, *Wright* and *Dialog*, teaches or suggests this limitation. Because the prior art references cited by the Examiner do not meet the requirements of 35 U.S.C. §103(a), the Applicants respectfully request that the Board of Patent Appeals rule in Applicants' favor and direct allowance of claims 1, 6 and 11.

3. Discussion of Applicants' Invention in View of the Prior Art References and Prior Art References Failure to Teach the Desirability of Applicants' Invention

For a rejection to stand under 35 U.S.C. §103(a), there must be a suggestion or motivation in the references themselves to modify the reference or combine the teachings.[9] Applicants' invention discloses a computer implemented system, method, and article of manufacture that converts a webserver function into a billable unit through a pre-assigned weight. Assuming the Examiner can provide that the *Wright* reference and the *Dialog* reference teach or suggest every element of the Applicants' invention, there is no motivation, suggestion or teaching to combine the two references under the standard of 35 U.S.C. §103(a).

In order to combine prior art references under 35 U.S.C. §103(a), the prior art references

[9] See MPEP §2143.

must have a suggestion or motivation to modify the references or combine the teachings.[10] "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure."[11] As noted by the Examiner, *Wright* fails to teach "the weight score assigned to the function prior to the use of the function."[12] The Examiner cited *Dialog* to support the contention that this missing element exists. However, there is no motivation in the prior art references for combining *Wright* and *Dialog*. Rather, the motivation for such a combinations stems from the language in Applicants' claims.

Wright teaches dynamically changing the rate associated with a webserver function after the webserver function has been accessed. Though the Applicants dispute that *Wright* provides a weight for each function, assuming the Examiner is able to prove otherwise, *Wright* also does not provide a user of the webserver function with advanced knowledge of the cost of the access since the rate is not pre-assigned. There is no teaching or suggestion in *Wright* to modify the invention for pre-assigning a rate to a webserver function, as the invention of *Wright* focuses on the dynamic element of the rate assignment. To modify the teaching of *Wright* for the pre-assignment rate structure as claimed by Applicants would go against the teaching of *Wright*.

Based upon *Wright's* teaching, it is clear that the Examiner is taking the elements of Applicants' pending claims and combining them in an improper manner. "It is impermissible to use the claimed invention as an instructions manual or 'template' to piece together the teachings

---

[10] See MPEP §2143.

[11] MPEP §2143, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

[12] Office Action of September 14, 2005, page 3.

of the prior art so that the claimed invention is rendered obvious." [13] Yet that is the very process that the Examiner has attempted to undertake. Most patents may be considered combination patents in which different elements are combined from prior art to achieve a new and useful apparatus and/or method. Although Applicants' invention may appear to combine elements found in different prior art disclosures, the motivation to combine the references must be in the prior art not in Applicants' pending claims. There is no motivation in the prior art to combine the reference, since such a combination would go against the teaching of *Wright*.

It is well settled that each statement of obviousness for the purpose of combining each of the numerous references of record must be found and suggested in the references themselves and not only in the fertile mind of the Examiner. The conclusive statements of the Examiner must be based upon specific evidence, suggestions and findings in the references of record relied upon by the Examiner in the rejection of the claimed subject matter. It is respectfully submitted that the record before us lacks any valid reasons to combine the references in the manner done so by the Examiner and contains unsupported reasoning suggested by the Examiner. The Examiner has not established a prima facie case of obviousness with respect to the aforesaid set of claims, there being no motivation to combine the references other than that disclosed in the Applicants' specification. "The best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references".[14] It is respectfully suggested that the Examiner's rejection under 35 U.S.C. §103(a) which contains neither teachings nor motivation to combine the references is without merit and must be withdrawn. Accordingly, Applicants respectfully

---

[13] *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ 2d 1780 (Fed. Cir. 1992), citing *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991).

[14] *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

contend that the combination of *Wright* with *Dialog* does not meet the standard set by the CAFC's interpretation of 35 U.S.C. §103(a), and respectfully requests that the Board of Patent Appeals rule in Applicants' favor and direct allowance of claims 1, 6 and 11.

C. Rejection of claims 4-5 and 18 under 35 U.S.C. § 103(a)

The Examiner rejected claims 4-5 and 18 under 35 U.S.C. §103(a) as being unpatentable over *Wright*, U.S. Publication No. 2001/0027449, in view of "Dialog's DialUnits: A Price Increase in Sheep's Clothing" (hereinafter *Dialog*). However, the Examiner's evaluation of the *Wright* and *Dialog* references did not take into account that both references lack fundamental limitations of the Applicants' invention. Because these basic requirements to uphold a rejection under 35 U.S.C. §103(a) were not met, Applicants respectfully request that the Board of Patent Appeals rule in Applicants' favor and direct allowance of claims 4-5 and 18.

Claims 4-5 and 18 are dependent upon independent claim 1. As disclosed above, claim 1 teaches a method for billing comprising: assigning a weighted score to a webserver function, identifying a user, determining if the function is performed by the user, calculating an amount of usage by multiplying the number of times the function is performed by the pre-assigned weight for the function, tallying the amount of usage for each function and billing the user. Claim 4 teaches an additional element to claim 1 wherein a webserver function log file stores the number of times each function is performed. Claim 5 teaches an additional element to claim 1 wherein a user log file stores user access information of the function. Claim 18 teaches an additional element to claim 1 wherein the weighted score may be based on empirical data. Though the Examiner states that each additional element of dependent claims 4-5 and 18 is anticipated by *Wright* and *Dialog*, as discussed above, neither *Wright* nor *Dialog* disclose all of the elements of

the independent claim from which claims 4-5 and 18 are dependent.

To uphold a rejection under 35 U.S.C. § 103(a) for a dependent claim, all the claim limitations must be taught or suggested by the prior art.[15] In other words, the prior art reference must teach or suggest all limitations of the dependent claim and the independent claim from which it depends. "If an independent claim is nonobvious under 35 U.S.C. § 103(a), then any claim depending therefrom is nonobvious."[16] As shown above, Applicants' claim 1 discloses a weighted function variable (W) embodied in the following mathematical representation:

$$(F_1 * W_1) + (F_2 * W_2) +... (F_n * W_n) = U_{Total}$$

Both *Wright* and Dialog fail to teach this weighted function variable element (W) as taught in Applicants' claim 1. Rather, the mathematical representation of *Wright's* and *Dialog's* formula is as follows:

$$(F_1 + F_2 +...F_n) * R = B$$

Because both *Wright* and *Dialog* do not teach all of the limitations of independent claim 1, neither reference teaches all of the limitations of dependent claims 4-5 and 18. Accordingly, Applicants respectfully request that the Board of Patent Appeals rule in Applicants' favor and direct allowance to claims 4-5 and 18.

---

[15] MPEP 2143.03 (citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

[16] *Id.* (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

D. Rejection of claims 7-10 under 35 U.S.C. § 103(a)

The Examiner rejected claims 7-10 under 35 U.S.C. §103(a) as being unpatentable over *Wright*, U.S. Publication No. 2001/0027449, in view of "Dialog's DialUnits: A Price Increase in Sheep's Clothing" (hereinafter *Dialog*). However, the Examiner's evaluation of the *Wright* and *Dialog* references did not take into account that both references lack fundamental limitations of the Applicants' invention. Because these basic requirements to uphold a rejection under 35 U.S.C. §103(a) were not met, Applicants respectfully request that the Board of Patent Appeals rule in Applicants' favor and direct allowance of claims 7-10.

Claims 7-10 are dependent upon independent claim 6. As disclosed above, claim 6 teaches a system for billing comprising: a function that is assigned a weight and a user that may perform the function on the webserver such that a manager may track the number of uses of the function and may calculate a total usage by multiplying the weight of the function by the number of times the function was performed. Claim 7 teaches an additional element to claim 6 wherein a the usage amount is determined by multiplying the number of uses of the function by the preassigned weight. Claim 8 teaches an additional element to claim 6 wherein the total amount of usage by a user is added to get the usage amount. Claim 9 teach an additional element to claim 6 wherein the file is a webserver function log file. Claim 10 teaches an additional element to claim 6 wherein the file is a user log file. Though the Examiner states that each additional element of dependent claims 7-10 is anticipated by *Wright* and *Dialog*, as discussed above, neither *Wright* nor *Dialog* disclose all of the elements of the independent claim from which claims 7-10 are dependent.

To uphold a rejection under 35 U.S.C. § 103(a) for a dependent claim, all the claim

limitations must be taught or suggested by the prior art.[17] In other words, the prior art reference must teach or suggest all limitations of the dependent claim and the independent claim from which it depends. "If an independent claim is nonobvious under 35 U.S.C. § 103(a), then any claim depending therefrom is nonobvious."[18] As shown above, Applicants' claim 6 discloses a weighted function variable (W) embodied in the following mathematical representation:

$$(F_1 * W_1) + (F_2 * W_2) + \ldots (F_n * W_n) = U_{Total}$$

Both *Wright* and Dialog fail to teach this weighted function variable element (W) as taught in Applicants' claim 6. Rather, the mathematical representation of *Wright's* and *Dialog's* formula is as follows:

$$(F_1 + F_2 + \ldots F_n) * R = B$$

Because both *Wright* and *Dialog* do not teach all of the limitations of independent claim 6, neither reference teaches all of the limitations of dependent claims 7-10. Accordingly, Applicants respectfully request that the Board of Patent Appeals rule in Applicants' favor and direct allowance to claims 7-10.

E. Rejection of claims 12-17 and 20 under 35 U.S.C. § 103(a)

The Examiner rejected claims 12-17 and 20 under 35 U.S.C. §103(a) as being

---

[17] MPEP 2143.03 (citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

[18] *Id.* (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

unpatentable over *Wright*, U.S. Publication No. 2001/0027449, in view of "Dialog's DialUnits: A Price Increase in Sheep's Clothing" (hereinafter *Dialog*). However, the Examiner's evaluation of the *Wright* and *Dialog* references did not take into account that both references lack fundamental limitations of the Applicants' invention. Because these basic requirements to uphold a rejection under 35 U.S.C. §103(a) were not met, Applicants respectfully request that the Board of Patent Appeals rule in Applicants' favor and direct allowance of claims 12-17 and 20.

Claims 12-17 and 20 are dependent upon independent claim 11. As disclosed above, claim 11 teaches an article for billing comprising: a computer readable signal bearing medium storing instructions comprising: an instruction to preassign a weight to a webserver function, instructions for determining when the function is performed by a user, and instructions for calculating a usage amount by multiplying the number of functions performed by the pre-assigned weight. Claim 12 teaches an additional element to claim 11 wherein the instruction for calculating usage amount includes multiplying the number of uses of function by the weight. Claim 13 teaches an additional element to claim 11 wherein the total usage amount is determined by summing usage amounts. Claim 14 teaches an additional element to claim 11 wherein the file is a webserver function log file. Claim 15 teaches an additional element to claim 11 wherein the file is a user log file. Claim 16 teaches an additional element to claim 11 wherein the medium is a recordable data storage medium. Claim 17 teaches an additional element to claim 11 wherein the medium is a modulated carrier signal. Claim 20 teaches an additional element to claim 11 wherein changing of the weight score is based on empirical data. Though the Examiner states that each additional element of dependent claims 12-17 and 20 is anticipated by *Wright* and *Dialog*, as discussed above, neither *Wright* nor *Dialog* disclose all of the elements of the independent claim from which claims 12-17 and 20 are dependent.

To uphold a rejection under 35 U.S.C. § 103(a) for a dependent claim, all the claim limitations must be taught or suggested by the prior art.[19] In other words, the prior art reference must teach or suggest all limitations of the dependent claim and the independent claim from which it depends. "If an independent claim is nonobvious under 35 U.S.C. § 103(a), then any claim depending therefrom is nonobvious."[20] As shown above, Applicants' claim 11 discloses a weighted function variable (W) embodied in the following mathematical representation:

$$(F_1 * W_1) + (F_2 * W_2) + \ldots (F_n * W_n) = U_{Total}$$

Both *Wright* and Dialog fail to teach this weighted function variable element (W) as taught in Applicants' claim 11. Rather, the mathematical representation of *Wright's* and *Dialog's* formula is as follows:

$$(F_1 + F_2 + \ldots F_n) * R = B$$

Because both *Wright* and *Dialog* do not teach all of the limitations of independent claim 11, neither reference teaches all of the limitations of dependent claims 12-17 and 20. Accordingly, Applicants respectfully request that the Board of Patent Appeals rule in Applicants' favor and direct allowance to claims 12-17 and 20.

F. Conclusion

---

[19] MPEP 2143.03 (citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

[20] *Id.* (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

In view of the rejections presented by the Examiner in the Office Actions of February 26, 2006 and September 14, 2005, it appears clear on the record that none of the references whether read individually or together obviate Applicants' invention based upon the legal definition of obviousness. Although the prior art references cited by the Examiner relate to establishing a bill for Internet or telecommunication services, the prior art references, when combined, neither teach all of the elements as presented in Applicants' invention nor suggest the desirability of modifications present such that one skilled in the art would find it obvious to incorporate such modifications. In fact, neither *Wright* nor *Dialog* mentions or suggests the use of a pre-assigned weighted variable for each individual function. Furthermore, neither prior art reference teaches or suggests that the weighted variable may be multiplied by the number of times each respective function was performed by a user. Thus, neither *Wright* nor *Dialog* have the advantage of the Applicants' invention to account for the cost of varying functions performed by a user. Rather, both prior art references teach that all functions performed are added and multiplied directly by a rate. The Applicants' invention is advantageous in that the varying costs of the functions performed are able to be recouped by the Internet Provider through use of the pre-assigned weighted variable.

Finally, the prior art references do not teach, suggest, or motivate one to combine elements found in the prior art references such that the Applicant's invention is obvious. Rather, the only way to reach such a combination in this case is use of the Applicants' invention as a template for hindsight reconstruction of the prior art, and this type of reconstruction is improper. Accordingly, the prior art references whether taken individually or in combination do not render Applicants' invention obvious.

Applicants believe that those skilled in the art have failed to solve the problem as claimed

by Applicants, and, for the reasons outlined above, Applicants respectfully request the Board of Patent Appeals direct allowance of this application.

Respectfully submitted,

By: /Rochelle Lieberman/
Registration No. 39,276
Attorney for Applicants

Lieberman & Brandsdorfer, LLC
802 Still Creek Lane
Gaithersburg, MD 20878
Phone: (301) 948-7775
Fax: (301) 948-7774
email: rocky@legalplanner.com
Date: July 31, 2006

8. ***Claim Appendix:***

1. A computer implemented method for billing comprising:

assigning a weight score to a webserver function, wherein said score is a property of said function and said weight score is assigned to said function prior to use of said function by a user;

identifying said user;

determining if said function has been accessed by the user;

identifying a number of times the function is accessed in response to said determination;

calculating a fee based on an amount of time said user is logged;

calculating an amount of usage for each function by multiplying the number of times the function is accessed by the user with the weight assigned to the function;

summing said calculated amount for each accessed function;

multiplying said summation by a usage point; and

billing said user.

2. (Canceled)

3. (Canceled)

4. The method of claim 1, further comprising a webserver function log file to store said number of times said function is accessed.

5. The method of claim 1, further comprising a user log file to store user access information of said function.

6. A computer implemented system for billing a user in a service provider environment comprising:

(a) a function weight assigned to a webserver implemented function

prior to execution of said function, wherein said weight is a property of said function;

(b) a user identification;

(c) said function adapted to be accessed by the user from a file;

(d) a manager adapted to track a number of uses of the function accessed by the user;

(e) a fee calculated based on an amount of time the user is logged, and a usage amount calculated by combining the number of uses tracked by said manager with the weight assigned to the function.

7. The system of claim 6, wherein the usage amount is determined by multiplying the number of uses of the function by the weight assigned to that function.

8. The system of claim 6, further comprising a total amount of usage for the user by summing a quantity of said usage amount.

9. The system of claim 6, wherein the file is a webserver function log file.

10. The system of claim 6, wherein the file is a user log file.

11. An article for billing a user in a service provider environment comprising a computer-readable signal bearing medium storing instructions comprising:

instructions for preassigning a weight to a webserver implemented function;

instructions for determining at least one function that is accessed by the user from a file;

instructions for identifying the function accessed by the user responsive to said determination instruction;

instructions for calculating a fee based on an amount of time the user logged; and

instructions for calculating a usage amount by combining the number of uses of said function by the weight assigned to said function.

12. The article of claim 11, wherein the instructions for calculating usage amount includes multiplying the number of uses of the function by the weight assigned to the function.

13. The article of claim 11, further comprising instructions for determining a total amount of usage for the user by summing usage amounts.

14. The article of claim 11, wherein the file is a webserver function file.

15. The article of claim 11, wherein the file is a user log file.

16. The article of claim 11, wherein the medium is a recordable data storage medium.

17. The article of claim 11, wherein the medium is a modulated carrier signal.

18. The method of claim 1, further comprising changing said weight score based on empirical data.

19. Canceled

20. The article of claim 11, further comprising instructions for changing said weight score based on empirical date.

9. Evidence Appendix

MPEP § 2173.02

Graham V. John Deere Co., 383 U.S. 1 (1966)

Office Action of September 14, 2005

In re Royka, 490 F.2d 981 (CCPA 1974)

MPEP §2143

In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991)

In re Fritch, 972 F.2d 1260, 1266 (Fed. Cir. 1992)

In re Gorman, 933 F.2d 982, 987 (Fed. Cir. 1991)

In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999).

MPEP §2143.03

In re Fine, 837 F.2d 1071 (Fed. Cir. 1988)

Dialog's Dial Units: A Price Increase in Sheep's Clothing

U.S. Patent Publication No. 2001/0027449 to *Wright*

10. Related Proceedings Appendix

None